

DOCKET NO: 202489US6



RESPONSE UNDER 37 CFR 1.116-
EXPEDITED PROCEDURE EXAMINING
GROUP 2621

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
YASUO NOMURA, ET AL. : EXAMINER: JAMIE J. VENT
SERIAL NO: 09/771,557 :
FILED: JANUARY 30, 2001 : GROUP ART UNIT: 2621
FOR: INFORMATION PROCESSING :
APPARATUS AND METHOD AS
WELL AS PROGRAM STORAGE
MEDIUM

PETITION UNDER 37 C.F.R. § 1.181 TO ACCOMPANY
RESPONSE AND RECONSIDERATION UNDER 37 C.F.R. § 1.116

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

This Petition is in response to the Official Action mailed on October 19, 2006.

The Finality of the Rejection Issued on October 19, 2006 is Premature.

In the above captioned case, the first Official Action was issued on April 6, 2006. In the first Official Action, U.S. Patent No. 6,798,980 to Hashizume, was asserted against the pending claims under 35 U.S.C. § 103. The Hashizume (CIP) reference was the only reference asserted against the pending claims. The Hashizume reference is a continuation-in-part (CIP) of an earlier application filed on September 10, 1998 (Application No. 09/150,235). The Hashizume (CIP) reference only qualifies as prior art to the extent that certain cited portions of the Hashizume (CIP) are entitled to the 1998 priority date. The Hashizume (CIP) is entitled to the 1998 priority date only for commonly disclosed subject matter.

Applicants attempted to perform this analysis independently but were unable to obtain a copy of the Hashizume parent as this parent was abandoned and is not publicly available to the Applicants. As such, in the response to the first Official Action filed August 3, 2006, Applicants requested that the Examiner provide a copy of the Hashizume parent so that the analysis can be performed by the Applicants.

In the Action issued on October 19, 2006, the Examiner provided the requested copy of the Hashizume parent. However, the October 19, 2006 Action has been made final.

The Final Action of October 19, 2006 in the section titled "Response to Arguments" asserted that:

Applicant's arguments filed August 3, 2006 have been fully considered but they are not persuasive. Applicant argues on pages 2-3 that Hashizume et al (US 2003/0142955) does not have priority of current application as it claims priority to abandoned parent application 09/150,235. Please find enclosed the application 09/150,235 that establishes the priority of the Hashizume et al (US 2003/0142955) reference to September 10, 1998. The rejection is maintained.

The above noted response to Applicants' arguments has mischaracterized the Applicants' earlier submission. In the Applicants' earlier response, Applicants noted that the Hashizume (CIP) reference cited by the Examiner is a continuation-in-part application. As such, there are aspects of the Hashizume (CIP) disclosure **which are not entitled** to the September 10, 1998 priority date. Furthermore, Applicants noted that the Hashizume parent filing was not previously available to Applicants as it was abandoned. Thus, Applicants were unable to determine whether or not **the aspects of Hashizume cited by the Examiner in his rejection** were entitled to the September 10, 1998 priority date. The simple provision of this parent application for the first time does not in and of itself **establish priority for the aspects of Hashizume parent cited by the Examiner.**

As can be appreciated, this is the **first time** the Applicants have had access to the Hashizume parent.

Applicants respectfully submit that the finality of the current Office Action is clearly premature. Simply stated, Applicants had no previous means by which to examine the Hashizume parent application absent the supply of this application from the USPTO.

Applicants respectfully submit that the finality of the Official Action dated October 19, 2006 is premature and should be withdrawn.

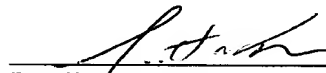
Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

BDL/SAM/ys



Bradley D. Lytle
Attorney of Record
Registration No. 25,599

Scott A. McKeown
Registration No. 42,866

I:\ATTY\SAM\PROSECUTION WORK\202489\202489US-PET181.DOC